

REMARKS

Disposition of the Claims

Claims 1-19 and 29-31 were originally filed. The Examiner correctly noted that claims 29-31 were previously misnumbered. In the Listing of the Claims, Claims 29-31 have been renumbered as 20-22. Claim 1 has been amended to remove reference to SEQ ID NO:3. The amendments to claims 1, 8, and 9 have not been made in response to a rejection by the patent office or for any reason relating to patentability, but instead has been made for commercial reasons. Claims 20-22 are identified as "Currently Amended", but only the claim numbering has been corrected and no change to the body of the claim has been made in response to a rejection by the patent office or for any reason relating to patentability. Claims 1-22 are therefore pending. Applicants request entry of this Response and the Amendments made in the Listing of the Claims. New Matter has not been added, and support for amendments is present in the originally filed application.

The Restriction Requirement

On page 6 of the April 17, 2006 Office Action, the Examiner proposes a separation of claimed peptides of the invention into 2 groups, which include Group I) SEQ ID NO:2 (and thus a search of SEQ ID NOS:1, and 4-7) and Group II) SEQ ID NO:3 (and thus a search of SEQ ID NOS:1, and 6-7. The Examiner further indicates that all of Groups II-V would be rejoined with Group I should either SEQ ID NO:2 or SEQ ID NO:3 eventually be determined to be novel.

Applicants hereby provisionally elect Group I referenced above, which includes SEQ ID NO:1-2 and SEQ ID NO:4-7, with traverse. Applicants respectfully submit that claims 1-31 (1-22) are sufficiently related to be properly examined together and without a serious burden on the

Examiner. Applicants direct the Examiner's attention to MPEP § 803, which provides that there are two criteria for a proper requirement for restriction between inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(j)); and

(B) There would be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 808<, and § 808.02).

The significance of both criteria is made further clear by the M.P.E.P. § 803:

If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions [emphasis added].

Applicants respectfully submit that the Examiner has not provided a *prima facie* case in support of restriction. The term "independent" means that there is no disclosed relationship between the two or more subjects disclosed in the application. That is, they are unconnected in design, operation, or effect. MPEP §802.01. As here, it is rare that this can form the basis of a proper restriction requirement as two completely unconnected inventions are generally not recited in a single application. The inventions of pending claims 1-31 (1-22) have a common focus in that the claims are related to a motoneuronotrophic factor peptide analogue, and in particular to a peptide subsequence of SEQ ID NO:1. SEQ ID NO:2 is a subsequence of SEQ ID NO:1, and likewise SEQ ID NOS:3-7 are subsequences of SEQ ID NO:1. Moreover, each of SEQ ID NO:1 and SEQ ID NOS:4-7 contain the complete sequence of SEQ ID NO:2. Applicants respectfully submit that it is not a serious burden for the Examiner to perform a search that encompasses each of SEQ ID NOS:2-7 because each of these peptide sequences are related and are contained within SEQ ID NO:1. Applicants are not requesting that every subsequence of SEQ ID NO:1 be searched, but rather submit that the including SEQ ID NO:3, which is a subsequence of SEQ ID NO:1, is not a serious burden on the Examiner. Applicants


are requesting that a total of only seven related SEQ ID NOS be searched and examined. This is not an unreasonable number that presents a serious burden on the Examiner. Indeed, the Manual of Patent Examining Procedure (MPEP) provides that normally ten sequences constitute a reasonable number. See MPEP 803.04, which states:

It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together. (emphasis added)

CONCLUSION

For the reasons set forth above, Applicants request reconsideration and withdrawal of the Restriction Requirement. Applicants respectfully submit that all pending claims in the application are in condition for allowance. The Examiner is encouraged to contact the undersigned if it is believed this would expedite prosecution. For the reasons described and supported above, Applicants respectfully submit that all pending claims are now in condition for allowance. That said, should any issues or questions remain, the Examiner is encouraged to telephone the undersigned at (619) 744-2240 so that they may be promptly resolved.

By: _____


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